LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
SEP 22 1965
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 601

THE GOODYEAR TIRE & RUBBER COMPANY, ET AL.,
Petitioners

v.

COMMISSIONER OF PATENTS, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

FRANCIS C. BROWNE
Counsel for Petitioners
1815 H Street, N. W.
Washington 6, D. C. 20006

Of Counsel:

J. D. WOLFE
Akron, Ohio.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

INDEX

		Page
I	Citations to Opinions Below	2
II	Jurisdiction	2
III	Questions Presented	2
IV	Statutes Involved	4
V	Patent Office Rules Involved	4
VI	Statement	4
	A. The Invention	4
	B. Patent Office Refusal to Issue Patent	5
	C. Remedy Sought in District Court	7
	D. Appeal to Court of Appeals	10
VII	Reasons for Granting the Writ	10
	Question 1. Due Process—Burden of Proof	10
	Question 2. Evidence—Prior Art	18
VIII	Conclusion	23
Appendix A		1a
Statutes		1a
Appendix B		4a
I. Proposed Patent Office Rule		4a
II. Patent Office Rules		5a
Appendix C(1)		8a
I. Decisions of Patent Office Board of Appeals		8a
Appendix C(2)		13a
Decision of District Court		13a

Page

Appendix C(3) 18a

Decision of Court of Appeals 18a

Appendix D 21a

Cases Dealing with Abandoned Applications as "Prior Art" 21a

Appendix E 22a

Appendix F 26a

Cases Showing No Presumption of Correctness Given Patent Office Ruling by CCPA 26a

CITATIONS

CASES:

Abbott v. *Coe*, 109 F. 2d 449 (CADC 1939) 10, 13, 14, 15, 16, 17

Alexander Milburn v. *Davis Bournonville*, 270 U.S. 390 .....5, 22

Asseff v. *Marzall*, 189 F. 2d 660 (CADC 1951) 21

In re Citron, 251 F. 2d 619 (CCPA 1958) 16

Hamilton Laboratories, Inc. v. *Massengill*, 111 F. 2d 584 (CA 6, 1940) cert. den. 311 U.S. 688, 61 S. Ct. 65, 85 L. Ed. 444 21

Hendrix v. *Ladd*, 301 F. 2d 527, 529 (CADC 1962) ...15, 17

In re Heritage, 182 F. 2d 639 (CCPA 1950) 20, 21

Morgan v. *Daniels*, 153 U.S. 120, 14 S. Ct. 772 (1894)..13, 14

In re Palmquist, 319 F. 2d 547 (CCPA 1963) 9

Schaefer v. *Watson*, 288 F. 2d 144 (CADC 1961) 10

OTHER AUTHORITIES CITED:

28 United States Code 1254(1) 2

35 United States Code 102 ..... 4, 9

35 United States Code 103 .....3, 4, 9, 19, 20, 21, 22

35 United States Code 122 .....4, 20

35 United States Code 133 3

Page

35 United States Code 135 3
35 United States Code 138 3
35 United States Code 141 .....3, 4, 8
35 United States Code 142 .....3, 4, 8, 17
35 United States Code 143 .....3, 4, 8, 17
35 United States Code 144 .....3, 4, 8, 17
35 United States Code 145 .....2, 4, 7, 17, 18
35 United States Code 151 3

Patent Rule 14 .....4, 14
Patent Rule 108 4
Patent Rule 135 4
Patent Rule 137 4
Patent Rule 138 ..... 3, 4
Patent Rule 314 3
Patent Rule 316 3

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No.

THE GOODYEAR TIRE & RUBBER COMPANY, ET AL.,
Petitioners

v.

COMMISSIONER OF PATENTS, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Petitioners pray that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, entered in the above-entitled case on June 24, 1965.[1]

---

[1] Petitioners are: The Goodyear Tire & Rubber Company, and Thomas H. Rogers, Jr., Newell R. Bender and Theodore B. Burkholder, assignors to The Goodyear Tire & Rubber Company.

I. CITATIONS TO OPINIONS BELOW

The Opinions of the Patent Office Board of Appeals (R. 330, 342) are unreported and are printed in Appendix C1 hereto, infra, pages 8a-12a, inclusive.

The Opinion of the District Court (R. 12), printed in Appendix C2 hereto, infra, pages 13a-17a, inclusive, is reported in 224 F. Supp. 781. The Opinion of the Court of Appeals, printed in Appendix C3 hereto, infra, pages 18a-20a, inclusive, is not yet reported.

II. JURISDICTION

The Judgment of the Court of Appeals for the District of Columbia Circuit was entered on June 24, 1965 (R. 472); Appendix C3, page 18a, infra. The jurisdiction of this Court is invoked under 28 United States Code 1254 (1).

III. QUESTIONS PRESENTED

Two questions are presented herein, the second of which is similar to a question presently before the Court in a case in which a Petition for Writ of Certiorari has been granted.

The first question presented in this Petition is:

1. Is it a denial of due process for the Courts of the District of Columbia Circuit to impose upon an applicant for patent the virtually insurmountable burden of showing, in a *de novo* civil action against the Commissioner of Patents in the United States District Court for the District of Columbia, under 35 U.S.C. 145, that the Patent Office, on the evidence which was before it, was *clearly erroneous* or *acted without rational basis* in refusing to issue the patent, particularly

where such burden is both inconsistent with and greater than the burden placed on the applicant in seeking judicial review of such refusal in the Court of Customs and Patent Appeals, as provided in 35 U.S.C. 141 to 144, inclusive, where the record is limited to the evidence produced before the Patent Office and the decision is confined to the points set forth in the reasons of appeal to that Court?

The second question[2] presented in this Petition is:

2. May an "abandoned"[3] patent application of one party be used as evidence of what the general fund of knowledge or "prior art" was during the time the "abandoned" application was "kept in confidence" and "preserved in secrecy" by the Patent Office pursuant to statute and Patent Office rules, to refuse a patent to another party on the ground of "obviousness" under 35 U.S.C. 103 when the application for patent was filed by the latter before such "abandoned" application became available for public inspection?

---

[2] A question similar to Question 2 of the present Petition is presently pending before the Court in *Hazeltine Research Inc. and Robert Regis*, Petitioners v. *David L. Ladd*, Commissioner of Patents, Respondent, October Term 1965, No. 57 (October Term, 1964, No. 919), Petition filed Feb. 18, 1965, Petition granted April 5, 1965, 85 S. Ct. 1108. In that case the reference relied upon was a "co-pending patent", whereas the present question relates to the use of an "abandoned" application as a reference.

[3] An "abandoned" patent application is an application which never became an issued patent because either: (1) the applicant failed to prosecute the application as required by 35 U.S.C. 133 and Patent Rule 135 or to pay the final fee required by 35 U.S.C. 151 and Patent Rules 314 and 316; or (2) the applicant filed an express abandonment of the application under Patent Rule 138.

IV. STATUTES INVOLVED

The statutes primarily involved are Sections 102, 103, 122 and 141 to 145, inclusive, of the Patent Act of July 19, 1952, C. 950, Sec. 1, 66 Stat. 792, 35 United States Code 102, 103, 122 and 141-145, inclusive. They are printed in Appendix A, infra, pages 1a-4a, inclusive.

V. PATENT OFFICE RULES INVOLVED

The Patent Office Rules primarily involved are Rules 14, 108, 135, 137, and 138. They are printed in Appendix B, infra, pages 4a-7a inclusive.

VI. STATEMENT

A. The Invention

An application for patent, designated as Rogers et al. application Serial No. 514,106, was filed by petitioners in the United States Patent Office on June 8, 1955 (R. 267-346).

Petitioners' invention claimed relates to a unique process for the manufacture of cellular, flexible polyurethane foam, a commercially important synthetic plastic material used for many industrial purposes. (R. 376-384, inclusive).

Petitioners discovered how to solve the problems of "fissuring" as well as control over cell size and uniformity of the synthetic plastic foam material. By utilizing petitioner's process it is possible to produce as much as 70% first class material whereas only 30% to 40% first class material could be produced prior to the discovery of petitioners' process. (R. 246)

B. Patent Office Refusal to Issue Patent

The application was examined and, on March 15, 1956, was first rejected on Newell Patent 2,676,157, issued April 20, 1954 (R. 286). An amendment was filed and reconsideration of the rejection was requested on behalf of petitioners on August 31, 1956 (R. 287-288).

About nine months later (on May 17, 1957) the Examiner responded to the amendment, withdrew his rejection on Newell Patent 2,676,157, supra, but, instead, rejected petitioners' application on Hoppe et al. Patent 2,764,565 which had just issued on September 25, 1956 on an application filed August 8, 1955 (R. 289), which was a date *after* the filing date of petitioners' application.

Inasmuch as the Hoppe et al. patent was NOT a "co-pending patent"[4], as that term is used in *Alexander Milburn* v. *Davis Bournonville,* 270 U.S. 390, the effective date thereof was not early enough to constitute a reference against petitioners' application. The Examiner recognized that the application on which the *patent* issued to Hoppe et al. was filed too late to be a valid reference as a "co-pending" patent and thereupon switched reliance to an "abandoned" *application* of Hoppe et al., Serial No. 327,522, filed December 23, 1952 (R. 289), which was referred to in the aforementioned patent, contending that the effective date of the "co-pending" *patent* as a reference was retroactive to the filing date of the "abandoned" *application.*

---

[4] A "co-pending patent", as defined in the petition of Haseltine (October, 1965 Term, No. 57), is one *issued after* the filing date of a patent application against which it is cited, but based upon an application *filed before* the patent application or patent in issue.

The "abandoned" application of Hoppe et al. merely disclosed and claimed the concept of making rigid, semi-rigid or elastic polyurethane plastics by *introducing one or more of the reactants into the mixture by high frequency intermittent injection of the reactant.* Nothing was said in the "abandoned" application about *maintaining* pressure on the reaction mixture while thoroughly blending the reactants, or that cell diameter could be *increased* by mixing under pressure of 0.5 to 60 pounds per square inch.

The "co-pending" patent did, *later,* refer to maintaining a pressure of that magnitude during the thorough mixing of the reactants. The filing date of that application, however, was *after* the filing date of petitioners' application.

The Examiner contended that some pressure inherently existed throughout the mixing of the materials after the high pressure, intermittent, high frequency injection of one or more of the components. This was shown to the Trial Court to be erroneous, as a matter of scientific principle, since the components were not thoroughly mixed when they reached the mixing chamber and since the mixing chamber was open to the atmosphere the mixed components flowed out of the chamber by gravity rather than being under superatmospheric pressure in the chamber.

Since the portions of the Hoppe et al. *patent* relied upon by the Examiner, column 6, lines 35-41 (R. 459), did not appear anywhere in the "abandoned" application of Hoppe et al. (R. 347-367), he took the position that the invention claimed by petitioners would have been "obvious" to one having ordinary skill in the art *at the time the "abandoned" application was filed.*

In an amendment filed November 12, 1957 (R. 291) the lack of foundation for the Examiner's rejection was pointed out by petitioners.

The Examiner again, on April 29, 1958, rejected the petitioners' application as "unpatentable" over the Hoppe et al. *patent* (R. 293), citing page 6, lines 17-19[5] of the "abandoned" *application*. However, even that passage did not appear in the issued Hoppe et al. *patent* (Compare: R. 454-464). The Examiner's action concluded with the statement that "The instant claims lack invention over Hoppe et al." (R. 294).

Petitioners filed an appeal to the Patent Office Board of Appeals on October 24, 1958 seeking reversal of the Examiner's refusal to issue a patent to petitioners (R. 294).

The Board of Appeals affirmed the Examiner in a decision rendered November 13, 1961, stating that "the appealed claims define nothing patentable over the cited reference", the "reference" being the Hoppe et al. *patent* (R. 330-332). Reconsideration of the Board's decision was requested (R. 333-342), but the Board refused to change its decision (R. 342-343).

C. Remedy Sought in District Court

A civil action was brought against the Commissioner of Patents pursuant to 35 U.S.C. 145 on February 28, 1962, petitioners having elected to obtain relief from the action of the Patent Office by way of a trial de novo, as provided in that section of the Patent Act of 1952 (R. 5-10), rather than taking an "appeal" to the Court of Customs and Patent Appeals pursuant

[5] This passage corresponds to the first three lines of the first full paragraph, R. 351.

to 35 U.S.C. 141 to 144, inclusive. This case was tried by the District Court for the District of Columbia in May, 1963 (R. 3).

The District Court, after hearing testimony in open court, receiving documentary evidence which was not before the Patent Office and witnessing a demonstration of the invention, dismissed the Complaint on December 23, 1963, holding that "it is apparent that at least two sets of inventors made the same invention at approximately the same time" and that "This fact, coupled with the fact that the evidence did not show that plaintiffs' invention solved a long-standing problem in the art * * * tends to negate plaintiffs' contention that their invention was an unobvious advance in the art." (R. 15).

The Court went on to say:

> "Of course it should also be noted that during the trial, several expert witnesses testified that plaintiffs' invention would not have been obvious to them in view of the disclosure in the Hoppe et al. application. However, this opinion evidence must be balanced and tested against the above-mentioned facts. Admittedly, this case is extremely close, but for the reasons given above, the Court cannot say that the tribunals of the Patent Office were *clearly erroneous* in holding that the claims in suit were unpatentable over the Hoppe et al. patent. (Emphasis petitioners)
>
> * * * *
>
> In view of what has hereinbefore set out, the Court holds that the decision of the Board of Appeals has not been shown to be in *clear error,* and that judgment should issue for the defendant and against the plaintiffs." (R. 16). (Emphasis petitioners)

With regard to the reliance of the Patent Office on the *abandoned* Hoppe et al. application to antedate petitioners' filing date, the District Court held:

> "The parties agree that only the disclosure brought forward from application Serial No. 327,522 is available as a reference since only that disclosure has a filing date earlier than the filing date of plaintiffs' application." (R. 13)[6]

Notwithstanding the fact that the statute under which judicial review was sought provides for a *trial de novo,* and the only issue to be decided by the Court was whether or not "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertaining", the District Court attached to the ruling of the Patent Office *a presumption of correctness which could be rebutted only by demon-*

---

[6] This was before the decision of the United States Court of Customs and Patent Appeals handed down *In re Palmquist,* 51 CCPA 839; 319 F. 2d 547 (Decided June 28, 1963) became final and before decision *In re Foster* (Decided April 15, 1965), 343 F. 2d 980 (overruling Palmquist, supra, in part), in which a Petition for Writ of Certiorari is now pending before this Court under No. 347, October Term, 1965.

Had the Hoppe et al. patent *issued* before petitioners *filed* the application in suit, the *abandoned* Hoppe et al. application referred to in the issued patent might have been effective as of its filing date as a reference under Section 102 *if it completely disclosed the invention in suit* since it would then have been available to the public. Whether or not it is a proper reference under Section 103, even under those circumstances is within the scope of the question presented in In the Matter of *Foster,* supra.

strating that there was "clear error or lack of rational basis in that decision," citing *Abbott et al* v. *Coe,* 109 F. 2d 449 (CADC 1939) and *Schaefer* v. *Watson,* 288 F. 2d 144 (CADC 1961). (R. 14)

D. Appeal to Court of Appeals

Appeal was duly taken to the Court of Appeals for the District of Columbia Circuit on January 17, 1964 and was argued there on October 12, 1964. Eight months later, in a *Per Curiam* Opinion dated June 24, 1965, the Court of Appeals affirmed the Judgment of the District Court, stating:

> "The Patent Office held that this disclosure [of the *abandoned* Hoppe et al. application] would suggest the process of mixing the ingredients under pressure to one with ordinary skill in the art. Although some evidence at trial conflicted with this holding, the District Court agreed with the Patent Office, relying on its expertness and stating that obviousness was indicated by the facts that another inventor had discovered the process at about the same time as appellants did and that the problem was not of long standing in the art.[3]
>
> The Patent Office's expertness in determining technical questions such as obviousness requires affirmance of its judgments *unless they have no rational basis.*[3] Since the Patent Office's finding of obviousness is supported by the record, the District Court's judgment *is not clearly erroneous.*[4]" (R. 474) (Emphasis petitioners' and citations omitted)

VII. REASONS FOR GRANTING THE WRIT

Question 1. Due Process—Burden of Proof

The first question presented is an important question of law which the Supreme Court has not previously considered and involves a conflict and inconsist-

ency between the United States Court of Appeals for the District of Columbia Circuit and the United States Court of Customs and Patent Appeals as to the burden of proof required by the respective courts of an applicant for a patent to overcome the refusal of the Commissioner of Patents to issue the patent sought. The current importance of the question is eloquently illustrated by the article entitled "The Scope of Review of the Court of Customs and Patent Appeals: Time for a Change?" 33 George Washington University Law Review 955, April 1965.

The patent laws of the United States, beginning as early as 1793[7] have provided a remedy for the refusal of the government to issue a patent to one party where another party also claimed the right to the patent. The early statutes provided for the appointment of a Board to arbitrate the matter. Their decision or award was final as to the granting of the patent.

In 1836 there was a general revision of the patent laws which, among other things, gave the duty of issuing patents to a Commissioner. The remedy provided in that act for refusal of the Commissioner to issue a patent was by way of submission of the matter to a disinterested three-man Board of Examiners appointed by the Secretary of State, at least one of the Examiners, preferably, being knowledgeable or skilled in the art to which the invention pertained.[8] The Commissioner and the applicant were afforded "an oppor-

[7] Act of February 21, 1793; Chap. XI, Sec. 9—Appendix E, page 22a.

[8] Act of July 4, 1836; Chap. 357, Sec. 7; 5 Stat. 117—Appendix E, page 22a.

tunity of furnishing them with such facts and evidence as they may deem necessary to a just decision."

If, however, the Board of Examiners refused an application on the ground it would interfere with an unexpired patent, any interested party could have remedy by a "bill in equity" in a Court having cognizance thereof.[9] Whereas judicial review of the action of an administrative agency is normally by way of direct "appeal" to a Circuit Court of Appeals *on the record made in the agency, the remedy by way of a civil action against* the Commissioner to obtain a patent is unique in the administrative process.[10]

Thus, at least since 1836, the refusal of the Patent Office to issue a patent has been subject to review in proceedings in which new evidence could be introduced. Legislative histories of the early acts show that the *equitable* actions against the Commissioner of Patents have always been in the nature of new trials. The actions have often been characterized as trials *de novo*.

Shortly after the establishment of the Circuit Courts of Appeals in 1891, the law provided, as an alternative remedy for the refusal of the Commissioner to issue a patent, a direct "appeal" to the Circuit Court for the District of Columbia *on the record made in the Patent Office*. In 1929 the jurisdiction of such direct "appeals" was transferred to the Court of Customs

---

[9] Act of July 4, 1836; Chap. CCCLVII, Sec. 16—Appendix E, page 25a.

[10] See West Publishing Company Chart. "The Judicial System of the United States", 1964 Revised Edition—Heading "Original Jurisdiction", "A. Civil Actions", "28" and pink "boxes" in upper right hand corner of chart.

Appeals and the name of that Court was changed to the Court of Customs and Patent Appeals.

While equity actions authorized by the patent laws have consistently been in the nature of new trials where new evidence could be introduced Courts having jurisdiction of such actions have attached varying degrees of presumptions of correctness to Patent Office decisions. In 1894[11], this Court had occasion to define the burden to be borne by a plaintiff in an *inter partes* action in equity in the Federal Court seeking to overturn an adverse decision in the Patent Office in an "interference" proceeding to which the Commissioner was not a party. In that case, the Court, having pointed out that the Patent Office had already determined the only question involved, namely: which of the contending parties was the prior inventor and, therefore, was entitled to receive the patent, stated:

> "* * * where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction."

No decision of this Court nor any enactment of Congress has modified the rule laid down in *Morgan* v. *Daniels,* supra. Yet in 1939, a decision of the Court of Appeals for the District of Columbia Circuit in *Abbott* v. *Coe*[12], wherein an applicant was refused a patent over an earlier reference, applied a more strict

---

[11] *Morgan* v. *Daniels,* 153 U.S. 120; 14 S. Ct. 772 (1894).

[12] 109 F. 2d 449.

burden of proof which requires an infinitely greater quantum of evidence to overcome the *ex parte* refusal of the Patent Office to issue a patent to an applicant.

Since *Abbott* v. *Coe,* supra, the Courts for the District of Columbia have demanded proof that the Patent Office *ex parte* refusal to issue the patent was at least "clearly erroneous" or lacks a "rational basis."

In deciding the present case, the Court of Appeals demanded the degree of proof set forth above, stating:

> "The Patent Office's expertness in determining technical questions such as obviousness requires affirmance of its judgments *unless they have no rational basis.*" (Emphasis petitioners')

In place of a burden of establishing his case "by testimony which in character and amount carries thorough conviction", as ruled by the Supreme Court in *Morgan* v. *Daniels,* supra, the District of Columbia Circuit now requires a plaintiff not only to show that the Patent Office decision complained of is *irrational* but that irrationality must be shown by more than a mere preponderance of the evidence. Petitioner is, therefore, saddled with an evidentiary burden which is virtually impossible to meet in practically all circumstances. Irrationality is seldom, if ever, the cause of erroneous decisions. Yet proof of irrationality by more than a mere preponderance of the evidence is now a prerequisite to reversal of the Patent Office, according to the United States Court of Appeals for the District of Columbia Circuit.[13] Requiring proof by evidence

---

[13] By comparison such a burden is not even required in the various Circuit Courts of Appeals when they strike down *issued* patents which carry a statutory presumption of validity as well as an ordinary presumption of correctness in the issuance of the patent.

which carries "thorough conviction" that the action was irrational, is tantamount to requiring proof "beyond a reasonable doubt" that error has been committed by the refusal of the Patent Office to issue the patent sought.

This standard of proof binds the District Court to an affirmance of the Patent Office in virtually every case. As stated by Circuit Judge Danaher in his dissent in *Hendrix* v. *Ladd*, 301 F. 2d 527, 529 (CADC 1962):

> "The District Judge obviously felt bound by and relied upon Abbott v. Coe, as his opinion shows. We had made him its prisoner by the status we had accorded to a mere presumption."

Even though petitioners demonstrated to the trial court in the present case that the Patent Office was clearly in error, the court was, in the language of Judge Danaher, a prisoner of the dogma of *Abbott* v. *Coe* and was compelled to affirm where nothing more than the status of a mere presumption should have been accorded that decision.

Although Congress has seen fit, for nearly a century and a half, to provide a remedy for applicants who are dissatisfied with Patent Office decisions by permitting equitable actions against the Commissioner of Patents, the Court of Appeals for the District of Columbia Circuit in *Abbott* v. *Coe* effectively abolished this avenue of review by imposing on the aggrieved party a burden of proof equal to that required to obtain a conviction in a criminal action.

On the other hand, in the Court of Customs and Patent Appeals, where the review is by appeal *on the record made in the Patent Office,* the appellant merely

has the burden of convincing at least three of the five Judges of that Court that the applicant is entitled to receive the patent and that Court does not hesitate to substitute its own judgment for that of the Patent Office. It is apparent from a reading of the decisions of the Court of Customs and Patent Appeals that it accords almost no presumption of correctness to Patent Office decisions, freely substitutes its own opinion on issues of fact and even resolves doubts in favor of applicants. It has said so in so many words in some of its recent opinions, even going so far as to resolve doubts *in favor of* the appellants where the record is limited to that made before the Patent Office and the decision goes beyond the errors assigned in the reasons for appeal.[14]

Petitioner well realizes the reticence and distaste with which the Court of Appeals for the District of Columbia Circuit, as well as the District Court, approach and exercise their jurisdiction over cases arising out of the Patent Office under the statute. However, the Courts of this Circuit, being the only Courts before which cases of this type arise in the United States, should be cautious so as not to avoid by judicial construction the very function which the statute has conferred upon them.

The Courts of the District of Columbia, by applying the virtually insurmountable evidentiary tests of *Abbott* v. *Coe*, supra, have, in effect, overruled a statute of Congress and denied a statutory judicial remedy to every disappointed applicant for patent. This is a de-

---

[14] See, for example, *In re Citron*, 251 F. 2d 619 (CCPA, 1958) and other cases cited in Appendix F, page 26a.

nial of due process of law which this Court should rectify.[15]

This leaves the applicant on the horns of a dilemma. He will have to choose between an appeal to the Court of Customs and Patent Appeals *on the record made before the Examiner* or be confronted with the virtually insurmountable burden of proving, by new and additional evidence, before the Courts of the District of Columbia that the Patent Office *acted without rational basis* in refusing to issue a patent. Since the applicant is required to show that the Patent Office acted *irrationally,* he is in effect denied the *de novo* equitable consideration to which he is entitled in the civil action, and is therefore denied the due process intended to be afforded as a remedy under 35 U.S.C. 145.

Congress has seen fit to give applicants for patent a *choice* of remedies when the Patent Office refuses to issue a patent. On the one hand, it provides for an appellate review, in the normal sense of the word, before the five-Judge Court of Customs and Patent Appeals solely on the record made in the Patent Office. 35 U.S.C. 141-144. It appears from 35 U.S.C. 142 and 144 that only those points as to which error is specifically assigned may be determined by that Court. On the other hand, Congress provided in 35 U.S.C. 145 for a civil action[16] in which the Court is authorized to

---

[15] It should be noted, however, that such result is not condoned unanimously by the Court of Appeals as is evident from the dissent of Judge Danaher in Hendrix v. Ladd, supra. Prior to Abbott v. Coe, supra, Judge Edgerton, the author of the opinion in that case, had dissented when the Court of Appeals held against the Patent Office. See *Carbide & Carbon Chemicals Corp.* v. *Coe,* 102 F. 2d 236 (CADC 1938).

[16] The antecedent statute, RS 4915, enacted prior to the abolition of the distinction between actions at law and actions in equity, specified that the action against the Commissioner of Patents would be by way of a "bill in equity".

"adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, *as the facts in the case may appear*" (Emphasis petitioners'). In other words, Congress has conferred on the District Court for the District of Columbia the right to determine whether or not a patent should be granted. In so doing it is not limited to the evidence which was before the Patent Office, but may make such determination on the whole of the evidence produced at trial, regardless of the previous refusal of the Patent Office to issue a patent on the limited amount of evidence which was before the Examiner in the Patent Office.

It is contrary to statute and therefore denial of due process for the Courts of the District of Columbia Circuit to fail to exercise their statutory duty to determine the issue of patentability *de novo,* as required by 35 U.S.C. 145. We are not concerned, at the moment, with the duty of the Court of Customs and Patent Appeals to limit its consideration to matters of *reversible error* committed by the Patent Office or to argue that the burden imposed by that Court on applicants is too light. However, the anachronism which exists between the presumptions attached to the Patent Office findings by the tribunals having *de novo* jurisdiction to determine patentability and those attached by the Court having only *appellate* jurisdiction to consider alleged error in those findings should be resolved.

Question 2. Evidence—Prior Art

The second question presented herein, insofar as it revolves around the issue of what constitutes "prior" art is similar in some respects to the question pending

before the Court in *Hazeltine* v. *Ladd*, supra, certiorari granted April 5, 1965, 85 S. Ct. 1108. In that case, the Hazeltine patent application was refused on the ground of "obviousness" under 35 U.S.C. 103 on "prior art" consisting of a "co-pending patent" (i.e., a patent *issued after* the filing date of the Hazeltine application on an application *filed before* the Hazeltine application).

In the present case, however, petitioners' application for patent was refused on the same ground ("obviousness" under 35 U.S.C. 103) on a reference consisting of a *patent* which *issued after* the filing date of petitioners' application, but (contrary to the facts in Hazeltine) upon an *application* which was *filed after* petitioners' application was filed. In both the Hazeltine case and the present case the reference patent issued on an *application* which was "kept in confidence" and "preserved in secrecy" at the time the petitioners' applications were filed, but both were used as "art" under Section 103 to refuse the respective patents sought.[17]

The question presented herein differs from that presented in Hazeltine in that the reference relied on by the Examiner in the present case was an *abandoned application* which was filed before petitioners' application was filed, but which *never matured into a patent*

---

[17] The question in *Foster* v. *United States* (October Term, 1965 No. 347) differs somewhat in that the reference in that case was a publication which was published *after* Foster *made his invention*, but published more than a year *before* Foster *filed his application* for patent.

and is still not open to public inspection except under specified terms and conditions.[18]

The importance of this question is emphasized by the fact that Section 103 of the Patent Act of 1952 provides that a patent may be obtained if the *differences* between the subject matter sought to be patented and the PRIOR ART be such that the *subject matter as a whole* would not have been obvious to a person having *ordinary* skill in that art AT THE TIME THE INVENTION WAS MADE BY THE APPLICANT FOR PATENT. There is such uncertainty as to what is meant by the words "prior" and "art" as used in Section 103 in the term "prior art" that the matter should be settled by the Supreme Court.[19]

The Courts have stretched the use of "abandoned" applications to a point beyond that contemplated by the patent laws and even beyond the constitutional concept of promoting the progress of science and the useful arts by encouraging prompt and full disclosure to the public of the discoveries made by inventors. This is brought out in the opinion of Judge Jackson, speaking for the Court of Customs and Patent Appeals *In re Heritage,* 37 CCPA (Patents) 1109, 182 F. 2d 639. He stated that "any reference to a disclosure *which is*

---

[18] An "abandoned" application, by definition, cannot possibly constitute "art" since it is not made, known or accessible to the public, as a matter of right. This can never come about under the present statute (35 U.S.C. 122) or rules (Patent Rule 14). After a patent issues, a member of the public may have access to the file of that patent, but must file with the Commissioner of Patents a "Petition for Access" to the file of any "abandoned" application referred therein to determine the contents of the latter. Prior to issuance of a patent making reference thereto, access may be had, if at all, only by consent of the applicant, the assignee or the attorney of record.

[19] See "Abandoned Applications as Prior Art"—Journal of the Patent Office Society, Vol. XLV No. 8, August, 1963, pp. 613 et seq.

available to the public is permissible" (emphasis added by petitioners), citing *Hamilton Laboratories, Inc.* v. *Massengill,* 111 F. 2d 584 (CA 6, 1940), cert. den. 311 U.S. 688, 61 S. Ct. 65, 85 L. Ed. 444. In the latter case a thesis on file in a college library was held to be a part of the "prior art". In the *Heritage* case an "abandoned" application referred to in a patent *issued before* the Heritage application was filed[20] was held to be proper evidence of the "prior" art.

While it appears to be a small step from treating a thesis in a college library as "art" to treating an "abandoned" patent application as "art", not too much violence is done so long as each is available to the public *prior* to the time a member of the public makes an invention or files an application for patent thereon. But now the Patent Office, in a proposed rule would make access to such applications or even knowledge of the existance thereof practically impossible. (Appendix B, page 4a.)

The Supreme Court has decried the rule by which Courts of Appeals have affirmed the judgment of the District Court where only two Appellate Judges vote for affirmance. In the trial of patent cases, particularly, such a rule should not be applicable. Nevertheless, the Court of Appeals for the District of Columbia, in the present case, relies upon the two-judge decision of *Asseff* v. *Marzall,* 189 F. 2d 660 (CADC 1951) to sustain the ruling of the District Court on the evidentiary effect of an earlier filed patent application as a reference to refuse a patent under 35 U.S.C. 103.

In *Asseff* v. *Marzall,* supra, relied upon by the Court of Appeals in the present case, however, the Court

---

[20] The Heritage application was filed September 9, 1939, whereas the Finck *patent*, in which reference was made to an earlier filed abandoned application *issued* August 22, 1933.

went beyond all reasonable bounds. In that case, the Cook patent which was relied upon as a reference was a "copending patent" *at the time the Asseff application was filed,*[21] thus bringing the case squarely under the rule of *Alexander Milburn* v. *Davis-Bournonville,* supra.

All of the foregoing cases were decided before the effective date of the Patent Act of 1952.

There is set forth in Appendix D, page 21a, a table setting forth the cases decided prior to the Patent Act of 1952 and those decided since the effective date of that Act, wherein reliance has been placed on an "abandoned" application as a reference to refuse a patent.

It is respectfully submitted that the question of availability of "abandoned" applications as "art" or "prior art" is an important question imbued with a significant public interest since the principle applies not only when a patent is sought but also when the validity of an issued patent is contested in a Court action. Inasmuch as the appellate tribunals are far from being in agreement as to the applicability of

---

[21] The Cook patent issued March 14, 1944, on an application filed November 8, 1941, whereas the Asseff application was not filed until September 9, 1942. Asseff admitted that the Cook application disclosed his invention but proved that he made the invention prior to November 8, 1941. He contended, therefore, that the reference was not "prior" art under the Milburn rule. However, the disclosure of an earlier filed Cook application as well as that part thereof which was carried forward into the application upon which the Cook patent was based were *direct anticipations* of the invention claimed by Asseff (See Opinion of Judge Tamm, deciding the case in that Trial Court, *Asseff* v. *Kingsland,* 86 F. Supp. 419, 423). Thus the earlier application was evidence of the fact that Asseff was not the first inventor of the subject matter of the invention claimed.

"abandoned" applications as references to *refuse* patents under 35 U.S.C. 103, the question presented in the present petition may be considered simultaneously with *Hazeltine* v. *Ladd,* supra.

VIII. CONCLUSION

Petitioners pray that the present petition be granted as to the first question since it is obvious that the public, the Patent Office and the inferior Courts are in dire need of a direction from the Supreme Court as to the burden of proof which is required of patent applicants to overcome the refusal of the Patent Office to issue a patent when they seek their statutory remedy in the respective Courts.

The second question, one aspect of which is already before the Court in *Hazeltine* v. *Ladd,* supra, should be considered in its entirety by the Court in order that it may have before it a case in point with respect to the use of "abandoned" applications as references as well as the use of "co-pending" patents as references, both in determining whether a patent should issue to another party and in determining the validity of a patent already issued.

Petitioners pray, therefore, that the petition, in its entirety, be granted.

Respectfully,

FRANCIS C. BROWNE
Counsel for Petitioners

Of Counsel:

J. D. WOLFE
Akron, Ohio.